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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,524	12/18/2001	Patrick D. Kilgannon	27866/34162A	8164

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MARSHALL, GERSTEIN & BORUN LLP
233 S. WACKER DRIVE, SUITE 6300
SEARS TOWER
CHICAGO, IL 60606

EXAMINER

DUFFY, PATRICIA ANN

ART UNIT PAPER NUMBER

1645

DATE MAILED: 10/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/025,524

Applicant(s)

KILGANNON ET AL.

Examiner

Patricia A. Duffy

Art Unit

1645

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 December 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 02 December 2004. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: 23-26.
Claim(s) objected to: _____.
Claim(s) rejected: 27.
Claim(s) withdrawn from consideration: 18-22.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Patricia A. Duffy
Patricia A. Duffy
Primary Examiner
Art Unit: 1645

Continuation of 11. does NOT place the application in condition for allowance because: Applicants arguments are not persuasive to remove the rejections of record. Applicants argue that "specific" is not exclusive but merely not-cross reactive with structurally related molecules. The passage of the specification is not a limiting definition because it does not define structurally related and moreover, things that hybridize are structurally related and therefore, the arguments are apparently inconsistent. Further, the argument is not commensurate with the claims which specifically require "structurally relatedness" by means of hybridization language of the claims. Therefore, if specific binding is not exclusive and excludes something "Structurally related" then it is unclear how the language defines the claims. The recitation of ICAM-4 does not convey a conserved structure/function and the specification does not teach what is meant by "structurally related" and since the alleged definition is open-ended and contrary to the claims which require structurally related material the argument is not persuasive. As to Applicants arguments in regard to claim 27, Applicants arguments are clearly not commensurate with the claims. The specification teaches a single sequence and specific fragments. The specification does not teach any natural variants per se. The specification does not teach any monoclonal antibody that binds the alleged natural variants. The specification does not teach the genus of natural variants and the claims are not limited to such. Applicants have not disclosed the genus, mere recitation of human ICAM-4, does not set forth possession of the genus of human variants. Applicants have not isolated by natural or recombinant hybridization means the claimed. the claimed monoclonal antibodies were raised against a specific polypeptide sequence (SEQ ID NO:28). In contrast to Applicants arguments, Fiddes is relevant to the instant situation because the claim requires a polypeptide that is encoded by a nucleotide that hybridizes. Applicants were not in possession of naturally occurring variants that hybridize. As such, could not have been possession of monoclonal antibodies that bind hybridizing variants. Applicants have not provided a fully characterized antigen with respect to the hybridizing variants for reasons made of record. Applicants arguments with respect to the art is also not persuasive. Applicants argue that the sequence or close variant is not disclosed in the art. This is not persuasive, the skilled artisan does not have to be in possession of the protein sequence in order to make a monoclonal antibody. Applicants argue specificity of the antibody and cross reactivity hypotheticals, however it is noted that the claims as acknowledged by applicants include human variants and the telencephalin is the same as human ICAM-4. Mere sequencing of the polypeptide or cloning the gene encoding such does not provide patentability for the antibody that binds the polypeptide. All rejections of record are maintained..